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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,749	02/26/2002	Edward Pinto	PIN01-002P	8454

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EXAMINER

CHOI, JACOB Y

ART UNIT	PAPER NUMBER
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2875

DATE MAILED: 12/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/085,749

Applicant(s)

PINTO ET AL.

Examiner

Jacob Y Choi

Art Unit

2875

AW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02/11/2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the retractable protruding member (whereby, the protruding member extends through the aperture by force from a resilient member in a resting stage and prevents removal of the display element), the affixing element is telescopic in nature (presented at differing heights), & the electricity wire must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 5, 7, 11, & 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hillinger (USPN 5,319,365).

Regarding claims 1 & 11, Hillinger discloses an removable display element (18) that is removably attached to a support element (12) by an attaching means (18D), a light bulb (62) being positioned on the support element (12) such that the light bulb illuminates the display element (18), an electrical power source (60), and the support element being removably affixed to a surface (44). Hillinger does not specifically disclose but rather shows differently shaped removable lens head (figure 1, 2, 4, & 5) that may be interchangeable due to removable lens head structure from the support element.

Claims in a pending application should be given their broadest reasonable interpretation. In re Pearson, 181 USPQ 641 (CCPA 1974), where Hillinger clearly show a quick disconnect assembly of the display element which may be differently shaped or designed.

Regarding claim 2, Hillinger discloses the claimed invention, explained above. In addition, Hillinger discloses the display element has a top region that is aesthetically designed and a bottom region that attaches to a top end of the support element via an attaching means (figures 2 & 5).

Note: aesthetic - characterized by a heightened sensitivity to beauty (Hillinger discloses the display element that is appealing to eyes of one)

Regarding claim 5, Hillinger disclose the claimed invention, explained above. In addition, Hillinger discloses a bottom end of the support element being distal to the top end (12F), the support element being tubular (12) in nature such that the bottom end

has an opening (12F) for frictionally (it is inherent that two surfaces that are touching creates friction) receiving an affixing element therein (40, 44, & 34).

Regarding claim 7, Hillinger disclose the claimed invention, explained above. In addition, Hillinger discloses a bottom end of the support element being distal to the top end, the support element being tubular in nature such that the bottom end has an opening for frictionally receiving an upper end of an extending element therein, the extending element having an lower end that is distal to the upper end, the extending element being tubular in nature such that the lower end receives a top boundary of an affixing element therein a frictional manner, an affixing end of the affixing element being distal to the top boundary and removably attaching to a surface.

Regarding claim 18, Hillinger disclose the claimed invention, explained above. In addition, Hillinger discloses the power source is obtained from commercially available electricity wired thereto.

4. Claims 3, 4, & 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hillinger (USPN 5,319,365) in view of Moriel (USPN 5,263,788).

Regarding claims 3, 4, & 12, Hillinger disclose the claimed invention except the specific details of coupling member. Moriel discloses the attaching means being defined by at least an aperture defined by at least an aperture through the wall and able to receive a retractable protruding member extending from the support element, whereby, the protruding member extends through the aperture by a force exerted by a resilient member in a resting stage and prevents removal of the body. It would have

been obvious to one having ordinary skill in the art at the time the invention was made to use modification in Hillinger as taught by Moriel in order to utilize other well known coupling method to removably secure the display element to the support element.

5. Claims 6, 8, 13, 14, 16, & 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hillinger (USPN 5,319,365) in view of either Bosnakovic (USPN 6,454,228) or Her (USPN 5,278,735).

Regarding claims 6, 8, 13, & 14, Hillinger disclose the claimed invention, except the affixing element is telescopic. Bosnakovic or Her teaches the affixing element is telescopic. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use modification in Hillinger as taught by Bosnakovic or Her in order to adjust the height of the display element.

Regarding claim 16, Hillinger disclose the claimed invention, except the specific material that is used for the display element. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the display element from a translucent polymeric compound (a group consisting of polystyrene & polyethlylene), since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claim 19, Hillinger disclose the claimed invention, except the lamp apparatus to be impenetrable to liquids. The functional recitation that "the support element are manufactured to be impenetrable to liquids" has not been given patentable

weight because it is narrative in form. In order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function, as set forth in 35 USC § 112, 6th paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279.

6. Claims 9, 10, & 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hillinger (USPN 5,319,365) in view of Shalvi (USPN 6,120,165).

Regarding claims 9, 10, & 15, Hillinger disclose the claimed invention, except the details of rechargeable battery being powered by a solar cell. Shalvi teaches that the power source is a rechargeable battery that is recharged by a solar cell that is affixed to an outer wall of the support element and is in communication with the rechargeable battery therethrough. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use modification in Hillinger as taught by Shalvi in order to simplify outdoor lamp with self powered electrical power source & its solar cell to be located within the lamp structure without utilizing long strands of electrical wires that is connected to the power outlet.

7. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hillinger (USPN 5,319,365) in view of Moriel (USPN 5,263,788), either Bosnakovic (USPN 6,454,228) or Her (USPN 5,278,735), and Shalvi (USPN 6,120,165).

Regarding claim 20, Hillinger disclose the claimed invention as explained above, and similarly Moriel, either Bosnakovic or Her, and Shalvi teaches the missing known prior arts of coupling method, rechargeable battery and its solar cell, and telescoping cylinder member to adjust the height of the lamp housing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use modification in Hillinger as taught by Moriel, either Bosnakovic or Her, and Shalvi and the same motivation to combine following references applies.

The examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

Response to Amendment

8. Examiner acknowledges that the applicant has amended claims 1, 3, 4, 11, & 20.

Response to Arguments

9. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gross (USPN 5,850,999) – light cover quick and safe release device

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Y Choi whose telephone number is (703) 308-4792. The examiner can normally be reached on Monday-Friday (10:00-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (703) 305-4939. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-7724.

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